

REMARKS

The Office Action mailed May 10, 2010 has been reviewed and carefully considered. No new matter has been added.

Claims 1, 12, 19, 27, 28, 33, and 37 have been amended. Claims 1-50 are pending.

Initially applicant acknowledges the Examiner's indication of allowable subject matter. In particular, claims 41-50 are allowed over the prior arts of record.

Claims 1-40 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Of Claims 1-40, Claims 1, 12, 19, 27, 28, 33, and 37 are independent Claims, and are each directed to a process/method. Method Claims 1, 12, 19, 27, 28, 33, and 37 have been amended to each now recite, *inter alia*, "In a video encoder, a method..." (emphasis added). Support for the amendment may be found at least at Figure 4, element 700, page 4, lines 28-31, page 8, lines 7-8, page 21, line 15 to page 22, line 14, noting that Figure 4 show a plurality of circuits (e.g., 760, 716, 728, 730) in the encoder 700 of Figure 4. Thus, process Claims 1, 12, 19, 27, 28, 33, and 37 recite that such processes are performed in a video encoder and, hence, are tied to the statutory class of apparatus, thus satisfying the first prong of the machine or transformation text set forth in *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008), which requires that a statutory process under 35 U.S.C. 101 must (1) be tied to another statutory category, or (2) transform underlying subject matter to a different state or thing. Moreover, we note that as per MPEP 2111.02(I), "[a]ny terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation". Accordingly, Claims 1, 12, 19, 27, 28, 33, and 37 are believed to satisfy the requirements of 35 U.S.C. 101 for at least the preceding reasons. As Claims 2-11, 13-18, 20-26, 29-32, 34-36, and 38-40 directly or indirectly depend from Claims 1, 12, 19, 28, 33, and 37, respectively, Claims 2-11, 13-18, 20-26, 29-32, 34-36, and 38-40 are believed to satisfy the requirements of 35 U.S.C. 101 for at least the same reasons as Claims 1, 12, 19, 28, 33, and 37. Thus, reconsideration of the rejection is respectfully requested.

Claims 1-6 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Publication No. 20020034249A1 to Kadono (hereinafter "Kadono"). Claims 7-10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kadono in view of U.S. Patent Publication No. 20060165175A1 to Yin (hereinafter "Yin"). The rejections are respectfully traversed.

It is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest the following limitations recited in Claim 1:

In a video encoder, a method of inter coding a pixel region of a current picture in a video sequence of pictures, the sequence including a plurality of references listed in at least one reference list, the method comprising: the step of selecting the first reference listed in a reference list to be used as the only reference to be used to encode the pixel region of the current picture.

Against the aforementioned limitations of Claim 1, the Examiner cited the following:

As per claims 1, 12 Kadono teaches a method of inter coding a pixel region of a current picture in a video sequence of pictures, the sequence including a plurality of references listed in at 5 least one reference list, the method comprising: the step of Selecting the first reference (see paragraph [0019-0020] [0024] [0092-0093] listed in a reference list to be used as the only reference to be used to encode the pixel region of the current picture (see paragraph [0025] [0036] [0040] [0094]).

Initially, we point out that the Examiner has incorrectly parsed Claim 1 when specifying correspondence between the claim limitations and Kadono. For example, Claim 1 actually recites, *inter alia*, “selecting the first reference listed in a reference list”, and not simply selecting the first reference. Accordingly, each of cited paragraphs [0019] and [0092] of Kadono simply disclose the following in their respective entireties: “3. The first picture in a scene is selected.” Paragraphs [0020] and [0024] of Kadono further relate to scenes. However, as is known, the first picture in a scene as disclosed in Kadono does not necessarily imply at all the first picture in a reference list as explicitly recited in Claim 1. Paragraph [0094] simply discloses, in pertinent part, that representative picture coding means 15 “determines the reference relationship for using the representative picture as a reference picture of predictive coding”. However, none of these cited paragraphs disclose “selecting the first reference listed in a reference list”. In fact, none of these

cited paragraphs even mention a reference list in the first place, let alone the limitations involving the same recited in Claim 1.

Continuing on regarding the further limitations recited in Claim 1, the Examiner cited paragraphs [0025] [0036] [0040] [0094] of Kadono. However, while Claim 1 is directed to a method of inter coding, paragraph [0025] of Kadono is directed to decoding and, hence, has no bearing on the limitations recited in Claim 1, and nonetheless fails to teach such limitations even assuming arguendo that such paragraph pertained to encoding. For example, paragraph [0025] discloses representative pictures, noting that the same is specified therein in plural form, with such plural form used throughout the disclosure of Kadono. Moreover, we note that a coded signal can include more than one picture, and nothing in Kadono refutes the same but instead supports the same (see, e.g., paragraph [0027], disclosing “a coded signal consisting of representative pictures....”). Paragraph [0036] of Kadono does not mention a reference picture or a reference picture list at all. Paragraph [0036] simply mentions the phrase “pixel region” and discloses that whether such pixel region is encoded or not is based on the transparent state of the pixel value and, further, if coded, such coding is by a predetermined coding method. Paragraph [0040] can be deemed to relate to the prior art described in the background section of the application (see, e.g., instant application, p. 2, lines 16-32) in that a reference picture is selected from a picture group, but does not limit the same to the first reference listed in a reference list as explicitly recited in Claim 1.

Lastly, we note that the entire disclosure of Kadono fails to include even one occurrence of the phrase “reference list” or similar phraseology (noting that a “reference list” is a well known term of art), let alone the detailed limitations involving the same. This is not surprising, as Kadono does not relate at all the solution of Claim 1, and hence, involves a completely different approach all together. For example, Kadono discloses the following at paragraph [0014] thereof: “According to the invention, a technique of layered coding is employed in which a moving picture is separated into layers such as a background, a foreground, and characters or pictures are separately prepared as one layer and coding is conducted on each layer.” Hence, such approach by Kadono does not involve nor is concerned with picture reference lists, let alone the detailed limitations involving the same recited in Claim 1.

Thus, Kadono fails to teach or suggest all of the above reproduced limitations of Claim 1. Moreover, while only Kadono was cited against independent Claim 1, it is respectfully asserted that the remaining reference Yin does not cure the deficiencies of Kadono and is silent regarding the same.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Hence, Claims 1 is patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Claims 2-10 directly or indirectly depend from Claim 1 and, thus, include all the limitations of Claim 1. Accordingly, Claims 2-10 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to Claim 1.

Reconsideration of the rejection is respectfully requested.

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In view of the foregoing, Applicants respectfully request that the rejections of the claims set forth in the Office Action of May 10, 2010 be withdrawn, that the pending claims be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No. 07-0832.

Respectfully submitted,

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